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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/522,628	PETIT, FREDERIC
	Examiner	Art Unit
	Kambiz Abdi	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,11,13-16,19,24-27 and 34-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,11,13-16,19,24-27 and 34-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

Claims 1, 3, 4, 11, 13-16, 19, and 24-27 are Amended.

Claims 2, 5, 6, 10, 17, 18, 20, 21, 28, 29, and 30-33 are canceled.

New claims 34-37 have been added.

Claims 1, 3, 4, 11, 13-16, 19, 24-27, and 34-37 are pending.

Response to Arguments

2. Applicant's arguments filed 11 October 2002 have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, 4, 7-9, and 11-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In independent claim 1 applicant points out "the software is associated with an information owner remote from the said external device" here the claim is missing the element of the system and means of transferring the acknowledgment to said "remote information owner".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international

application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-8, 10-12, and 19-22 are rejected under 35 U.S.C. 102 (e) being anticipated by Virgil M. Davis et. al., U.S. Patent No. 6,105,008.

As per claims 1 and 19, Davis discloses; a system for downloading information to an information device, comprising:

of an information device (See Davis figures 17,18A,18B, 18C)

at least one external device capable of transferring blocks of information

an acknowledgment process, wherein said acknowledgment process produces a verifiable acknowledgement of the transferred information (See Davis figures 17,18A,18B, 18C, and 18D column 4, lines 26-37, column 6, lines 50-68, and column 25, lines 20-55).

As per claims 2-5, 20, Davis discloses the limitations of claims 1 and 2. Davis further discloses; the verifiable acknowledgment is transmitted to said information owner and can only be interpreted by the information owner, in addition to be uniquely related to the transferred information it can be tested and validated by the information owner (See Davis figures 18A, and 18B column 26, lines 28-68 and column 27, lines 1-22).

As per claims 6-8, 21, 22, Davis discloses the limitations of claims 1and 19. Davis further discloses;

The external device is remotely located from said information owner and wherein said external device transfers the blocks of information on behalf of said information owner. The information device is a smart card, in addition, a card reader, wherein said smart card communicates with said external device via said card reader (See Davis figures 16 and 17 and column 4, lines 1-5 and lines 26-37, column 5, lines 3-13).

As per claims 10-12, Davis discloses the limitations of claim 1. Davis further discloses;

said acknowledgment process uses cryptography to produce the verifiable acknowledgement of the transferred information. This process is resident on said information device and at least one network, wherein the network facilitates communications among said information owner, said external device and

said information device (See Davis Figures 16 and 17 column 4, lines 26-36, column 5, lines 3-13 and lines 22-39).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3, 4, 7, 8, 11-16, 19, 22-27, and 34-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,317,832 to David Barrington Everett et al. in view of U.S. Patent No. 5,999,740 to David John Rowley and U.S. Patent No. 6,105,008 to Virgil M. Davis et al.

9. As per claims 1, 19, and 34, Everett clearly discloses a system for authenticating download of software to an information device, comprising:

- at least one external device capable of transferring the software to said information device (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, and column 4, lines 1-61),
- wherein the software is associated with an information owner remote from said external device, and
- wherein said software is transferred by said external device as delegated by said information owner (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, column 4, lines 1-61, and column 8, lines 50-68); and
- said information device configured to perform an acknowledgment process (See Everett figures 9 and 10 and associated text and column 3, lines 50-68, column 4, lines 1-61, column 8, lines 50-68, column 9, lines 15-61, and column 12, lines 20-64),

What Everett is not explicit about is the step of forwarding the acknowledgement of the successful download and installation to the information owner. However, Rowley clearly discloses a system that

automatically informs the information owner of the successful download (update) and installation of a software update (See Rowley figures 3A and 3B and associated text, and column 6, lines 13-62). Further more Davis clearly teaches the system of securely confirming the download of digital data to a remote information owner by way of a signature (See Davis column 25, lines 20-455, and column 26, lines 36-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Everett with the teaching of Rowley and Davis to greatly expand the capability of the Everett's invention for better security, higher level of control, and management of application downloads (Updates).

10. As per claim 3, Everett, Rowley, and Davis disclose all the limitations of claim 1, further; Everett, Rowley, and Davis disclose the claimed invention, as discussed above, except for the step of "verifiable acknowledgment can only be interpreted by said information owner". It would have been an obvious matter of design choice to modify the combined teachings of Everett, Rowley, and Davis, to provide the step of "verifiable acknowledgment can only be interpreted by said information owner", since applicant has not disclosed that solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Everett, Rowley, and Davis will perform the invention as claimed by the applicant with any method, means or product to verify acknowledgment can only be interpreted by said information owner.

11. As per claim 4, Everett, Rowley, and Davis disclose all the limitations of claim 1, further; Davis discloses that the verifiable acknowledgment is a digital signature uniquely related to said transferred software (See Davis column 26, lines 28-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to incorporate the teachings of Everett with the teaching of Rowley and Davis to greatly expand the capability of the Everett's invention for better security, higher level of control, and management of application downloads (Updates).

12. As per claims 7, 8, and 22, Everett, Rowley, and Davis disclose all the limitations of claims 1 and 19, further;

Everett clearly teaches the fact the information device is a smart card (See Everett figure 10 and associated text and column 2, lines 49-55, and column 14, lines 5-37).

13. As per claim 11, Everett, Rowley, and Davis disclose all the limitations of claim 4, further;

Davis discloses that the digital signature is produced using a cryptographic key resident on said information device (See Davis column 5, lines 22-39).

14. As per claim 12, Everett, Rowley, and Davis disclose all the limitations of claim 1, further;

Davis discloses that at least one network facilitates communications among said information owner, said external device and said information device (See Everett column 9, lines 1-14 and Davis column 4, lines 26-37).

15. As per claims 13-15 and 24-27, Everett, Rowley, and Davis disclose all the limitations of claims 1 and 19, further;

Everett clearly discloses that,

- software comprises new instructions to be stored on said information device (See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).
- software is an update of existing instructions stored on said information device (See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).
- software is a deletion of existing instructions stored on said information device(See Everett column 3, lines 62-68, column 4, lines 1-5, column 9, lines 1-14, and column 14, lines 21-36).

16. As per claim 16, Everett, Rowley, and Davis disclose all the limitations of claim 1, further;

Davis clearly discloses that the software comprises an applet (See Davis column 25, lines 39-45).

17. As per claims 35-37, Everett, Rowley, and Davis disclose all the limitations of claim 34, further; Davis clearly discloses

- acknowledgment process utilizes a symmetrical DES algorithm based on said cryptographic key (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).
- DES algorithm is a triple-DES algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27)..
- acknowledgment process utilizes a public-key encryption algorithm (See Davis column 19, lines 31-68, column 20, lines 1-68, and column 21, lines 1-27).

Additionally is understood that Everett, Rowley, and Davis disclose the claimed invention, as discussed above, except for the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications. It would have been an obvious matter of design choice to modify the combined teachings of Everett, Rowley, and Davis, to provide the step of utilizing a symmetrical triple DES encryption algorithm using a public key for verifications, since applicant has not disclosed that solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Everett, Rowley, and Davis will perform the invention as claimed by the applicant with any method, means or product to verify the encrypted acknowledgment .

18. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,317,832 to David Barrington Everett et al. and U.S. Patent No. 5,999,740 to David John Rowley and U.S. Patent No. 6,105,008 to Virgil M. Davis et al. further in view of U.S. Patent No. 6,496,979 to James Chen.

19. As per claims 9 and 23, Everett, Rowley, and Davis disclose all the limitations of claim 1, further; Chen clearly discloses a system for updating software and digital information in a personal digital assistant (See Chen column 2, lines 60-68, column 3, lines 25-30, and column 7, lines 34-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time the current invention was made to

incorporate the teachings of Chen with the teachings of Everett, Rowley and Davis to greatly expand the capability of the Everett's invention for additional mobile devices such as PDAs besides just limiting the system to the smart cards.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure U.S. Patent to:

U.S. Patent No. 5,444,861 to William B. Adamec, System for Downloading Software.

U.S. Patent No. 6,173,401 to Michael Deindl, Importing Information onto A Chip Card.

21. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202

Abdi/K
December 24, 2002

JOHN W. HAYES
John W. Hayes
PRIMARY EXAMINER